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71 Stonewall Court
Yorktown Heights, NY 10598-1819

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MAR 07 2005

In re Application of
O'Donnell-Kiely
Application No. 09/641,410
Filed: August 18, 2000

OFFICE OF PETITIONS
Decision on Petition

This is a decision on the petition under 37 CFR 1.137(a), filed October 18, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

History

A final Office action was mailed on March 9, 2004.

A reply to the Office action was filed on June 15, 2004 (Certificate of Mailing date of June 8, 2004).

In addition to an amendment, petitioner filed a paper which, in substance, is an affidavit under 37 CFR 1.131.¹

A portion of the reply was returned to petitioner. Specifically, the Office returned copies of three Disclosure Documents. Petitioner states the disclosure documents were originally filed on July 5, 1994, July 4, 1996, and May 1, 1999.

The absence of the copies of the Disclosure Documents, attached to the affidavit, failed to have an impact in so far as the affidavit was not considered. As stated in the advisory action, the affidavit was improper "because it is not directed **SOLELY** to issues which were newly raised by the Examiner in the final rejection." After a final rejection, an affidavit may only refer to issues which were newly raised by the examiner in the final Office action.² Therefore, the examiner would not have considered the missing copies of the Disclosure Documents even had they been present.

¹ 37 CFR 1.131(a) states, "When any claim of an application . . . is rejected, the inventor [or other qualified party] may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based."

² MPEP 715.09 states, with emphasis added, "Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 . . . are considered timely if submitted . . . prior to final rejection . . . or after final rejection [if] submitted (1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or (2) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or (3) under 37 CFR 1.129(a)."

Even if affidavit addressed new grounds of rejection, the examiner has stated in the advisory action that "no sufficient diligence appears to have been presented." The presence of absence of the copies of the Disclosure Documents would have had no effect on the examiner's determination regarding diligence.

The advisory was not based solely on problems with the affidavit. The proposed *amendment* was not entered because it raised new issues which would require further consideration or search.

The instant petition under 37 CFR 1.137(a) was filed on October 18, 2004.

Analysis:

A grantable petition under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee *if* the application was filed on or before June 8, 1995 or *if* the application is a design application.

The instant petition lacks items (1) and (3).

As to (1), petitioner has not submitted a reply which *prima facie* places the application in condition for allowance.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

A proper reply has not been filed.

Petitioner has not submitted a reply to the final Office action. A proper reply to a final rejection consists only of

- (A) an amendment which *prima facie* placed the case in condition for allowance,
- (B) a Notice of Appeal and the required fee, or
- (C) a Request for Continued Examination (RCE).

Petitioner must file a response to the final Office action in the form of (A), (B), or (C) before the a petition to revive may be granted.

As to (A), *prima facie* is a latin term meaning "on its face." Petitioner may only file an amendment at this stage if, on its face, it puts the application in condition for allowance. In fact, applicant does not have a "right" to amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims. An amendment will only be accepted if it merely cancels claims which have been rejected, adopts examiner suggestions, removes issues for appeal (if one were filing a Notice of Appeal also), or in some other way requires only a cursory/brief review by the examiner. If an amendment requires further searching by an examiner, it will generally not be accepted. An example of an acceptable amendment:

- a. Examiner files final rejection which states, "Claim #2 is rejected, however if the word 'plural' were deleted then the claim would be acceptable."
- b. An amendment is filed which deletes the word "plural"
- c. The amendment on its face is allowable, no further work by the examiner is required.

As to (B), petitioner may file a Notice of Appeal (and fee) and two months later file an appeal brief (and fee).

As to (C), a RCE can be filed. A RCE is basically a request to continue prosecution of the application. A "submission" (usually in the form of an amendment) and a fee must be submitted with the RCE. Petitioner may request that the amendment filed on June 15, 2004, be considered with the RCE or may request that the amendment filed on June 15, 2004, not be entered and file a new amendment. The amendment, on its face, does NOT have to place the application in condition for allowance in order for the amendment to be considered on the merits. Unlike "an amendment after final" where the applicant does not have the "right" to file an amendment, an applicant does have such a right when the amendment is filed with a RCE. To file a RCE requires an additional fee of \$395 (for a small entity) plus any applicable additional claim fees. A copy of a form that can be used is included for petitioner's convenience.

Petitioner has not filed a Notice of Appeal or RCE, but has only filed an amendment and affidavit. Per the advisory action, the affidavit was improper and the amendment failed to prima facie place the application in condition for allowance. Petitioner may wish to submit a RCE with any new petition to revive.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."³ The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁴ A lack of knowledge of, or failure to understand, a PTO rule, the content of the MPEP, or an Official Gazette notice will not constitute unavoidable delay.⁵

Petitioner appears to base her allegation of unavoidable delay on the fact that petitioner feels the failure to have the copies of the Disclosure Documents matched with the file was unavoidable. However, as stated previously, the application would have become abandoned even if the Disclosure Documents has been matched with the file. The Office notes that the only "Disclosure Documents" in the present file are blank forms which may be used to file "Disclosure Documents." Petitioner may wish to resubmit copies of the Disclosure Documents. The Office notes that the examiner will determine the extent to which petitioner may rely on the Disclosure Documents.⁶

Petitioner has failed to demonstrate the failure to file a proper replay was unavoidable. Therefore, the petition must be dismissed.

³ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

⁴ See In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912).

⁵ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

⁶ MPEP 1706 state, "The Disclosure Document will be preserved by the USPTO for two years after its receipt. It will then be destroyed unless it is referred to in a separate letter in a related patent application filed within the two-year period. The separate letter . . . must identify not only the patent application, but also the Disclosure Document by its title, number, and date of receipt in the USPTO."

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (still needs to be submitted), the required petition fee (\$750 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

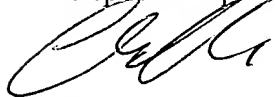
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Petitions Attorney
Office of Petitions

Attached: PTO/SB/30
PTO/SB/64